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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|--|-------------|-------------------------|-----------------------|------------------|
| 10/076,774   | 02/15/2002  | Nicholas Michael Masich |                       | 3719             |
| 7590   | 01/02/2004  |                         | EXAMINER              |                  |
| Nicholas M. Masich<br>316 Bowman Dr.<br>Woodbury, NJ 08096 |             |                         | ELVE, MARIA ALEXANDRA |                  |
|  |             |                         | ART UNIT              | PAPER NUMBER     |
|  |             |                         | 1725                  |                  |

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                          |
|------------------------------|-------------------------------|--------------------------|
| <b>Office Action Summary</b> | Application No.               | Applicant(s)             |
|                              | 10/076,774                    | MASICH, NICHOLAS MICHAEL |
|                              | Examiner<br>M. Alexandra Elve | Art Unit<br>1725         |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 27 October 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-3 is/are pending in the application.  
 4a) Of the above claim(s) 2 and 3 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.  
 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. It is not clear if applicant is disclosing a method of forming holes or a device that has laser pieced holes.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over DD 127358 (abstract).

DD (127358) discloses a nozzle plate (spinneret) in which laser piercing is used to form the holes. This nozzle is used to form glass fibers (filaments). DD (127358) does not teach the manufacture of synthetic filaments for the application to reduction of tread separation in tires.

It has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the nozzle to manufacture different types of filaments such as continuous synthetic filaments, because the extrusion nozzles (spinnerets) are functional equivalents.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06210858 A (abstract).

JP (06210858 A) discloses an inkjet nozzle in which the holes are formed by laser piercing. The reference does not teach the manufacture of filaments or the relationship to tire treads.

It has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the nozzle to disperse different materials because the type of materials chosen are a choice in design and substitutions of known equivalent structures may be made. In re Kuhle, 188 USPQ (CCPA 1975) and In re Ruff, 118 USPQ 343 (CCPA 1958).

#### ***Response to Arguments***

Applicant's arguments filed 10/27/03 have been fully considered but they are not persuasive.

In response to applicant's argument that prior art is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are directed to nozzles, which form glass filaments or process inkjets.

Applicant must clarify whether the invention (of claim 1) is a method, an apparatus or a product. In other words, is applicant's invention directed to a method of forming laser pierced holes in the spinneret or a spinneret product? Clarification is required. Additionally, because the applicant is a pro se, the examiner will not final this rejection. The examiner feels that an interview (in person or on the phone) would be beneficial to further prosecution of this application.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is 571-272-1173. The examiner can normally be reached on 6:30-3:00 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 571-272-1171.

December 20, 2003.

